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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,452	08/16/2001	Koji Nagata	35.C15682	1317

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EXAMINER
DIVINE, LUCAS

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 10/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/930,452	NAGATA, KOJI
	Examiner	Art Unit	
	Lucas Divine	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 July 2005*.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 July 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Claims 1 – 16 are pending.

2.   Drawing and Specification Objections withdrawn due to adequate amendments.

Response to Arguments

3.   Applicant's arguments filed 7/18/05 have been fully considered but they are not

persuasive. The 101 rejection is maintained for the same reason it was first applied – the

program is not claimed as embodied or stored on a 'computer-readable medium' such as in claim

16.   The arguments do not point out where in the claim this language is located and thus are

insufficient and not persuasive.

4.   Applicant's arguments with respect to claims 1, 6, and 16 with regards to Gunning have

been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

5.   Claim 1 is objected to because of the following informalities: the claim cites in the

prelude "**and forming ~~print~~ generating data**". Examiner believes that applicant meant to cross

out forming as is done in the other independent claims and would be consistent with the crossing

out of forming below in the same claim. Otherwise there would be two verbs, is the host

computer forming data or generating data or forming data that is generating etc. Appropriate

correction is required. Examiner has interpreted the claim as such in the rejections below.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6.   Claims 11 – 15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The computer program claimed is merely a set of instructions per se. Since the computer program is merely a set of instructions <u>not embodied on a computer readable medium</u> to realize the computer program functionality, the claimed subject matter is non-statutory. See MPEP § 2106 IV.B.1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1, 2, 6, 7, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salgado et al. (US 5872569).

        <u>Regarding claim 1</u>, Salgado teaches **an information processing apparatus** (e.g. 82, Fig. 5 and its description) **serving as a host computer** for **processing a printing request from an application and generating data which can be printed** (setting up job tickets through user

interface, col. 3 lines 50-62; col. 12 lines 31-48; col. 13 line 58 – col. 14 line 9) **by a printer (20,**

Fig. 1, col. 9 lines 39-57), comprising:

display control means (workstation 82 inherently includes a CPU and/or printer driver

for controlling display 142) **for controlling a display unit to display an output setting view**

screen in which a value of an output setting item is set (e.g. Fig. 12)**;**

paper size setting means (e.g. mouse 106 or keyboard 104 that sets the options shown in

the screen) **for setting an input paper size of a document inputted from the application (Fig.**

12, col. 21 lines 42-52) and an output paper size of print data printed by the printer (Fig.

12, col. 21 lines 53-65) via the output setting view screen displayed by said display control

means (Fig. 12 is shown in display 142)**; and**

generating means (84, Fig 5) **for generating the print data on the basis of the input**

paper size and the output paper size set by said paper size setting means (generating the

print data, col. 12 lines 31-48),

wherein when the input paper size is set, said display control means controls the

display unit to display a paper size which is supported as the output paper size by the

printer and a paper size which is not supported as the output paper size by the printer so

that they can be discriminated from each other (as shown in Fig. 12, the user selects the input

device and size [noted by dotted lines] and then the output options are shown, including options

that are not supported [e.g. GLDG 2 PRINTER and 11x17 for NORTH PRINTER], and a user

selects one that is supported [noted by dotted lines – e.g. 8 ½ x 11]; col. 21 lines 40-65; col. 14

lines 42-48)**, and when the output paper size is set, said display control means controls the**

display unit to display a paper size which is supported by the printer (Fig. 12 shows the item

as 'set' because it has dotted lines around it and it does display a paper size which is supported

by the printer [e.g. A3 and 8 ½ x 11),

wherein a number of the input paper sizes is larger than a number of the output

paper sizes (Fig. 12 shows that the number of input paper sizes can be larger than a number of

the output paper sizes [SCANNER 1 has 2 sizes, SOUTH PRINTER has 1 output size]).

It would have been obvious to one of ordinary skill in the art that the input paper sizes

could have more than the output paper sizes (as given in the example). The motivation for having

more input sizes might just be that's what is currently supported by the devices and that's what

the user has to work with. Other reasons why more input sizes might be than the output are well

known in the art. For example, if the NORTH PRINTER only had 8/12 x 11 and 11 x 17 while

the input SCANNER 1 had 8 ½ x 11, 11 x 17, and A3, it would be another obvious example.

Regarding claim 2, which depends from claim 1, Salgado teaches **said paper size setting**

means sets the input paper size and the output paper size in response to an instruction

which is inputted through a graphical user interface for performing a print setting (input by

mouse or keyboard or possibly microphone, Fig. 6 into graphical user interface shown in Fig. 12

and discussed in the rejection to claim 1).

Regarding claim 6, the structural elements of apparatus claim 1 perform all of the method

steps of method claim 6. Therefore, method claim 6 is rejected for the same reasons as stated

above in the rejection of apparatus claim 1.

Regarding claim 7, which depends from claim 6, the structural elements of apparatus

claim 2 perform all of the method steps of method claim 7. Therefore, method claim 7 is

rejected for the same reasons as stated above in the rejection of apparatus claim 2.

Regarding claim 16, which depends from claim 11, the method steps of method claim 6 are the same steps as performed by program claim 16. Further, Gunning teaches a processor 16 to execute program steps and a computer readable medium 30 to store program steps. Therefore, program claim 16 is rejected for the same reasons as stated above in the rejection of method claim 6.

Regarding claim 16, which depends from claim 12, the method steps of method claim 7 are the same steps as performed by program claim 16. Further, Gunning teaches a processor 16 to execute program steps and a computer readable medium 30 to store program steps. Therefore, program claim 16 is rejected for the same reasons as stated above in the rejection of method claim 7.

8.   Claims 5, 10, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salgado as applied to claims 1, 6, and 15 above, and further in view of Webb et al. (US 5727135) hereafter as Webb.

Regarding claim 5, which depends from claim 1, while Salgado teaches the indication of 'not available' or 'not supported' is done by "graying out" the option, Salgado does not specifically that paper size setting means adds a mark showing that the paper size is not supported to a position near a paper name of the input paper size corresponding to the paper size which is not supported by said printer and displays them.

Webb teaches adding and displaying a mark showing that an unavailable printing resource is unavailable, displaying the mark near to the name of the resource (Fig. 8, wherein mark 306 shows that the printer 304 is unavailable).

It would have been obvious to one of ordinary skill in the art that this type of user

notification could be used to also let the user know that other printer resources are unavailable or

unsupported, such as the paper size and/or printer of Salgado. The motivation for doing so

would have been to clearly notify the user that certain resources are unavailable. Both are

"graying out" and marks shown in Webb are well known indications that can be used in printing

user interfaces.

Regarding claim 10, which depends from claim 6, the structural elements of apparatus

claim 5 perform all of the method steps of method claim 10. Therefore, method claim 10 is

rejected for the same reasons as stated above in the rejection of apparatus claim 5.

Regarding claim 16, which depends from claim 15, the method steps of method claim 10

are the same steps as performed by program claim 16. Further, Gunning teaches a processor 16

to execute program steps and a computer readable medium 30 to store program steps. Therefore,

program claim 16 is rejected for the same reasons as stated above in the rejection of method

claim 10.

9.   Claims 3, 4, 8, 9, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Salgado as applied to claims 1, 6, and 11 above, and further in view of Morikawa (US 6741269).

Regarding claim 3, which depends from claim 1, while Salgado teaches a modern

printing system (Fig. 6) with many common features (discussed in col. 1 – 6) including scaling

(col. 4 line 38) and being able to select different output sizes from input sizes (Fig. 12), Salgado

does not specifically teach automatically setting a zooming print in the case where the input

paper size which is set by said paper size setting means is the paper size which is not supported by said printer.

Morikawa teaches automatically setting an enlarge/reduce print in the case where the input paper size is different from the output size (col. 6 lines 3-7).

It would have been obvious to one of ordinary skill in the art that when a paper size is unsupported and the document must be reduced/enlarged to be printed that an automatic scaling could be performed as is shown in Morikawa. The motivation for doing so would have been to take the burden off the user, who can be imprecise and allow the processor to handle the enlarging/reducing calculations for a more accurate scaling than if the user completed the task alone.

Regarding claim 4, which depends from claim 3, Morikawa further teaches the printing method can be changed by manual operation (Fig. 3 shows the user being able to select scaling ranges [see 93% and 100%]; col. 6 lines 9-10, wherein the operator touches keys to initiate scaling of the page size).

Regarding claim 8, which depends from claim 6, the structural elements of apparatus claim 3 perform all of the method steps of method claim 8. Therefore, method claim 8 is rejected for the same reasons as stated above in the rejection of apparatus claim 3.

Regarding claim 9, which depends from claim 8, the structural elements of apparatus claim 4 perform all of the method steps of method claim 9. Therefore, method claim 9 is rejected for the same reasons as stated above in the rejection of apparatus claim 4.

Regarding claim 16, which depends from claim 13, the method steps of method claim 8 are the same steps as performed by program claim 16. Further, Gunning teaches a processor 16

to execute program steps and a computer readable medium 30 to store program steps. Therefore, program claim 16 is rejected for the same reasons as stated above in the rejection of method claim 8.

Regarding claim 16, which depends from claim 14, the method steps of method claim 9 are the same steps as performed by program claim 16. Further, Gunning teaches a processor 16 to execute program steps and a computer readable medium 30 to store program steps. Therefore, program claim 16 is rejected for the same reasons as stated above in the rejection of method claim 9.

Conclusion

10.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lucas Divine
Examiner
Art Unit 2624

ljd

KING Y. POON
PRIMARY EXAMINER